

REMARKS

Claims 1-33 are pending in the Application.

Claim Rejections - 35 U.S.C. § 103

The Patent Office rejected claims 1-9, 11-20, 22-31 and 33 under 35 U.S.C. § 103(a) as being unpatentable over Applicants Admitted Prior Art ("AAPA") in view of U.S. Patent No. 6,587,457 by Mikkonen ("Mikkonen").

The Patent Office rejected claims 10, 21 and 32 under 35 U.S.C. § 103(a) as being unpatentable over Applicants Admitted Prior Art ("AAPA") in view of U.S. Patent No. 6,587,457 by Mikkonen ("Mikkonen") and further in view of U.S. Patent No. 6,363,065 by Thornton et al. ("Thornton").

Applicant respectfully traverses both rejections. Obviousness cannot be established by combining the teaching of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined only if there is some suggestion or incentive to do so. *ACS Hosp. Sys., Inc. v. Montefiore Hosp.*, 732 F.2d 1572, 221 USPQ 929 (Fed. Cir. 1984). Coupled with the requirement for motivation is the additional requirement that the suggestion or motivation to combine exist before the date of invention under 35 U.S.C. §103(a).

The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. It is impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that "[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." *In re Oetiker*, 977 F.2d 1443, 24 USPQ 2d 1443 (Fed. Cir. 1992) *quoting In re Fine*, 837 F.2d 1071, 1075, 5 USPQ 2d 1596, 1600 (Fed. Cir. 1988) (emphasis added). The suggestion and reasonable expectation of success, necessary for a rejection under 35 U.S.C.

§103(a), must be found in the prior art, not in the Applicant's disclosure. *In re Dow Chem. Co.*, 837 F. 2d 469, 473, 5 USPQ 2d 1529, 1531 (Fed. Cir.1988).

Regarding claims 1-33, the Examiner is improperly utilizing the Background of the Invention section of the present application as the motivation for combining FIGS. 1A-1B with Mikkonen. The Patent Office stated in Page 3 of the Office Action that it would have been obvious ... to have solved the problems in AAPA ... in light of the teachings of Mikkonen. [The problems present in the AAPA would not have been available to one of ordinary skill in the art prior to the date of the invention.] The Patent Office is improperly relying upon the basis of the problem set forth in the present application as the only motivation that one would utilize to combine the disclosure with Mikkonen. Thus, no motivation exists for one of ordinary skill in the art before the date of the present invention to combine the AAPA with Mikkonen.

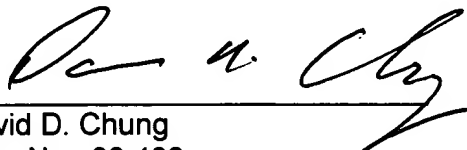
As the Examiner is well aware, Applicant is required to seasonably challenge statements by the Examiner that are not supported on the record, and failure to do so will be construed as an admission by Applicant that the statement is true. M.P.E.P. §2144.03. Therefore, in accordance with Applicant's duty to seasonably challenge such unsupported statements, the Examiner is hereby requested to cite a reference supporting the position that it would have been obvious to modify Mikkonen in accordance with the claimed invention. If the Examiner is unable to provide such a reference, and is relying on facts based on personal knowledge, Applicant hereby requests that such facts be set forth in an affidavit from the Examiner under 37 C.F.R. 1.104(d)(2). Absent substantiation by the Examiner, it is respectfully requested that the rejection under 35 U.S.C. § 103 be withdrawn.

Conclusion

Applicants respectfully submit that all claims are allowable, and it is respectfully requested that the entire application now be passed to formal allowance.

Respectfully Submitted,

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